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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,216	06/13/2001	Robert E. Richard	12013/59001	4088

23838 7590 07/03/2003

KENYON & KENYON  
1500 K STREET, N.W., SUITE 700  
WASHINGTON, DC 20005

EXAMINER
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MICHENER, JENNIFER KOLB

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/03/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/879,216

Applicant(s)

RICHARD, ROBERT E.

Examiner

Jennifer Kolb Michener

Art Unit

1762

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): Mehta et al.; 112 2nd.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13.  
10. ☐ Other: \_\_\_\_\_

**ADVISORY ACTION**

1. The reply filed June 5, 2003 fails to place this application in condition for allowance. The period for reply expires 3 months from the mailing date of the final rejection.

***Election/Restrictions***

2. Examiner notes with appreciation Applicant's cancellation of non-elected claims. The cancellation will be entered upon appeal.

***Claim Rejections - 35 USC § 112***

3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph. Examiner maintains the rejection.

4. The rejection of claim 11 under 35 U.S.C. 112, second paragraph, has been withdrawn based on Applicant's amendment.

***Claim Rejections - 35 USC § 102***

5. The rejection of claims 1-2, 4-8, 10-12, and 14-15 under 35 U.S.C. 102(e) as being anticipated by Mehta et al. (US 2002/0051845 A1) has been withdrawn based on Applicant's Declaration.

***Claim Rejections - 35 USC § 103***

6. The rejection of claims 3, 7, 9, and 13 under 35 U.S.C. 103(a) as being unpatentable over Mehta has been withdrawn based on Applicant's Declaration.

***Response to Arguments***

7. Applicant's arguments regarding the new matter rejection filed 6/5/2003 have been fully considered but they are not persuasive.

Applicant argues that the newly added claim limitation to "non-polymeric" medical devices is inherent in the specification because the specification discloses the use of stents (typically made of metal) and catheters (typically made of polymers). Therefore it is argued that the claims have been narrowed, instead of expanded.

Examiner disagrees.

There is no basis in the specification for claiming all non-polymeric materials. Non-polymeric materials may include, in addition to metals, fibrous or natural materials, ceramics, and minerals, among others. As outlined in the previous office action, there is no support for the claiming of all such non-polymers.

New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific species of a broader original disclosure.

Whatever may be the viability of an inductive-deductive approach to arriving at a claimed subgenus, it cannot be said that such a subgenus is necessarily described by a genus encompassing it and a species upon which it reads.

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**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kolb Michener whose telephone number is 703-306-5462. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jennifer Kolb Michener  
July 1, 2003



**SHRIVE P. BECK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1700**